

REMARKS/ARGUMENTS

Claims 1, 2, 6 and 8-10 are pending in this application and are under rejection. Claim 1 has been amended to more clearly recite applicant's method. No new matter is added by the claim amendments. Reconsideration of the patentability of applicant's claims is respectfully requested based on the amendments and remarks presented herein.

Request For Correction of Mailing Address

Applicant's representatives reiterate their request made on p. 5 of the response filed November 30, 2007, that all further correspondence concerning this matter be forwarded to Robert C. Faber, Esq. at the firm of Ostrolenk, Faber, Gerb & Soffen LLP located at 1180 Avenue of the Americas, New York, NY 10036-8403, Telephone (212) 382-0700, Facsimile (212) 382-0888 - Customer No. 2352. To date, the Patent Office has been mistakenly forwarding such correspondence to Phillips Intellectual Property & Standards, 595 Miner Road, Cleveland, Ohio 44143. The Ostrolenk firm was informed in February, 2008 by a representative of Phillips Intellectual Property & Standards that Phillips also notified the Examiner with regard to the error in the correspondence address and that the Examiner indicated that the Patent Office records would be corrected in this regard. Such correction is respectfully requested, therefore, if it has not been already made.

Rejections Under 35 U.S.C. §112

Claims 1-2, 6 and 8-10 are rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the 'written description' requirement of the statute. The Examiner alleges that the limitation, "such that a total void volume of said microspheres is greater than a total volume between the microspheres" is not supported by the specification as originally filed. This rejection is respectfully traversed.

In response to the rejection, applicant has amended claim 1 such that the indicated phrase now reads as follows, "a total volume of space within said microspheres is greater than a total volume of space between said microspheres". The Examiner states at p. 2 of the Office Action that, "it is not clear what constitutes volumes between the microspheres". As amended, therefore, the

phrase is clarified to read “volume of space”, i.e., between the microspheres. Further, the term “void” has been deleted due to the Examiner’s comment, also at p. 2 of the Office Action wherein the Examiner inquires, “what is the void volume of the microspheres (how thick are the walls)?”. Thus, instead of “void volume”, the phrase now reads, “total volume of space within the microspheres”. As is well understood, the microspheres are hollow and there is, thus, a hollow space within each microsphere, wherein the space in the case of each such microsphere would have a “volume” associated therewith. Thus, there would of course be a “total volume of space” within the totality of the microspheres.

The Examiner is respectfully reminded that the phrase under discussion was added to claim 1 in response to the Examiner’s §112, second paragraph rejection regarding the language “close packed “array. Applicant acknowledges the Examiner’s argument in the present Office Action that the figure presented with this application is marked as “diagrammatic” and is, thus, not a figure where all of the components are drawn to scale. However, applicant respectfully submits that, notwithstanding that the figure is not drawn to scale, one having an ordinary level of skill in this art would readily recognize and understand the intended scope of the presently claimed invention upon viewing the arrangement depicted in the figure, taken together with the written description contained in applicant’s specification, wherein the arrangement is described as a “close packed” array, see e.g., p. 3, line 23; p. 3, line 26 and p. 3, line 29.

Applicants representatives have been informed by the inventor of this application, who is clearly one having at least ordinary skill in this art, that the term, “close packed array” is well known to and in common use by those working in this field of technology and that it would be understood by any such individual to mean that the total volume within the microspheres in the present case, is greater than the total volume between the microspheres. If it would be of assistance in overcoming the §112 rejection, applicant would be willing to provide an evidentiary declaration describing the understanding of the meaning of ‘close packed’ array to those of ordinary skill in this art.

In summary, therefore, applicant respectfully submits that the phrase, “such that a total void volume of said microspheres is greater than a total volume between the microspheres”, which has been objected to by the Examiner has now been amended to clarify the wording, and further, that the phrase in its present (amended) form is entirely supported by the terminology ‘close packed array’

that appears at several locations in the application as filed, and which is exemplified in the drawing figure(s) provided with this application. That is, the phrase, “ such that microspheres” has been inserted simply by way of clarification, as requested by the Examiner, of the meaning of the term ‘close packed array’. For the reasons above, therefore, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 U.S.C. §112.

Claim Rejections Under 35 U.S.C. §103

Claims 1-2 and 6-10 are again rejected under 35 U.S.C. §103(a) as allegedly ‘obvious’ over AU patent application 200151857 to De Toffol [and] under 35 U.S.C. §103 as allegedly ‘obvious’ over its U.S. corresponding patent No. 6,476,087 to De Toffol. As claim 7 has been canceled in a prior response, applicant believes that the rejection was meant to apply to (only) claims 1, 2, 6 and 8-10. The §103 rejections are respectfully traversed by the applicant.

Several features believed to distinguish applicant’s claimed method over the cited references are discussed in detail in applicant’s prior responses filed in this application and those remarks are specifically incorporated herein by reference.

In order to further distinguish the method claimed by applicant over the cited art, applicant has further amended to claim 1 to recite that the excess liquid phase binder flows out of the mold only through the opening provided in the mold bottom for that purpose. This limitation is supported by the teaching contained at, for example, p.3, lines 27-28 of the specification and Fig. 1(d). That is, as taught by the detailed description of the invention and as illustrated in the drawing figure, the only location where the excess liquid phase is shown leaving the mold is through “opening 6” in the bottom of the mold.

The above-described arrangement contrasts, however, with the arrangement described by the De Toffol references. That is, notwithstanding whether there is a difference between “draining” and “wicking” as previously argued in applicant’s response dated November 28, 2005 (see, e.g, the last paragraph on p. 5 as well as p. 6), the Examiner in the “Response to Arguments” in the present Office Action (pp. 4-5) admits that the De Toffol reference describes a mold having pores over its entire surface, through which the excess liquid phase binder flows away from the close packed array microspheres contained within the mold and, thus, out of the mold. Thus, in contrast to the

arrangement described in De Toffol, i.e., wherein the liquid can and does leave the mold throughout the entire surface of such mold, in the presently claimed arrangement of applicant the excess liquid phase binder leaves the mold only through an opening ("opening 6") provided for the express purpose of draining the mold.

As previously noted, e.g., at p. 5 of applicant's response dated November 28, 2005, the arrangement recited in applicant's claim 1 is most effective in permitting the formation of a close packed array of microspheres as the end product, a result not taught by the cited references. Thus, not only is the method as presently claimed different from that disclosed in De Toffol, but the final product (a close packed array, i.e., defined as a situation wherein the total volume of space within the microspheres is greater than a total volume of space between the microspheres) also is distinguishable over the references.

For the reasons above, therefore, the Examiner is respectfully requested to reconsider and withdraw the §103 rejections based on the De Toffol references and to issue a Notice of Allowance with regard to all of the claims of the present application.

Respectfully submitted,

THIS CORRESPONDENCE IS BEING SUBMITTED
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